<u>REMARKS</u>

Claims 1-16 are pending in the present application. Claims 4-8 and 12-16 were withdrawn; claims 10 and 11 are amended; claim 17 is added. Reconsideration of the claims is respectfully requested.

I.   <u>Examiner Interview</u>

Applicants thank Examiner Bonschock for courtesies extended the Applicants' representative on June 18, 2008. During the interview, Applicants' representative pointed to differences observed between the *MSword* (prior knowledge reference) and *Foster* reference and the claims. Applicants' representative pointed out that with respect to claim 1, *Foster* does not show claim 1 recited, "displaying the graphical image associated with the icon in response to the icon preview instruction". Examiner Bonshock responded that *Foster* Col. 9, line 44 describes the icon preview instruction. Further, Examiner Bonschock alleged that *Foster* col. 9, lines 57 *et seq* describe the "displaying the graphical image". Examiner Bonshock replied that *MSword* teaches to place the mouse over an icon at *MSword* Figure 3, and **then, Figure 2** shows the popup after a predetermined time. The Examiner followed-up with and relied upon supplemental information, in the form of "Word 2000 Basic Manual page 8" (see IDS submitted herewith) that proved to Applicants' representative's satisfaction the timing of the *MSword* Figures 2 and 3 is controlled by the timing of the snapshots (see lower right corner), and not based on the Examiner's initial ordering of the figures, to wit:
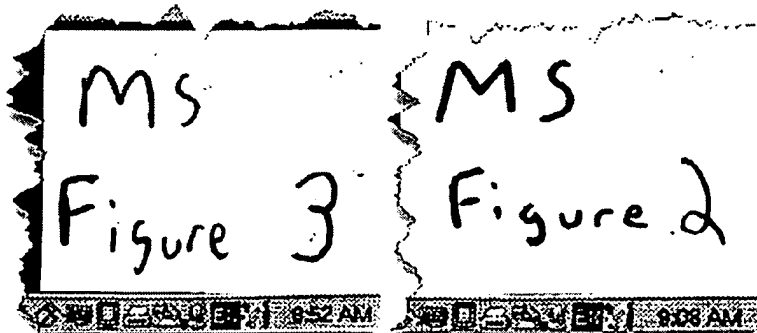
Since the Examiner relies on "Word 2000 Basic Manual page 8" as authoritative on the operation of Microsoft Word 2000 for a public use (known by others), Applicants will also rely on the document as describing operation of Microsoft Word 2000 in combination with a typical

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computer operating with a Microsoft operating system. Despite agreement on some facts concerning prior knowledge by ones other than the inventor, no agreement as to the propriety of allowing claims was reached.

II.   35 U.S.C. § 102 Anticipation

The Examiner has rejected claims 4-8 and 12-16 under 35 U.S.C. § 102 as being anticipated by Microsoft, "Microsoft Word," evidence of prior use during 1999, hereinafter *MSword*.

The claims 4-8 and 12-16 are withdrawn.

III.   35 U.S.C. § 103 Obviousness

The Examiner has rejected claims 1-3 and 9-11 under 35 U.S.C. § 103(a) as being unpatentable over *Foster* et al. (Patent Number 5,404,442, hereinafter *"Foster"*) in view of Microsoft, "Microsoft Word" (hereinafter *"MSword"*).

The examiner bears the burden of establishing a *prima facie* case of obviousness based on prior art when rejecting claims under 35 in U.S.C. §103. *In re Fritch*, 972 F.2d. 1260, 23 U.S.P.Q. 2d 1780 (Fed. Cir. 1992). Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusions of obviousness. *KSR International Co. versus Teleflex Inc.*, No. 04-1350 (U.S. April 30, 2007) (citing *In re Khan*, 441 F.3d 977, 988 (Fed. Cir. 2006)). Additionally, the prior art reference (or references, when combined) must teach or suggest all the claim limitations. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974).

With respect to claim 1, the claim recites (with emphasis):

> A method of previewing a graphical image corresponding to an icon in a clipboard, comprising:
> receiving an icon preview instruction from a user; and
> *displaying the graphical image associated with the icon in response to the icon preview instruction.*

The Examiner concedes that *MSword* does not teach the claim 1 recited, "displaying the graphical image associated with the icon in response to the icon preview instruction". The

Examiner makes this admission with the passage below:

> MSword, however, doesn't specifically teach displaying a *graphical image* associated with the icon in response to the icon preview instruction (see board decision of 1-4-2008).

Office Action dated June 5, 2008 p. 6 (emphasis added).

The Examiner alleges that *Foster* teaches the claim 1 recited, "displaying the graphical image associated with the icon in response to the icon preview instruction." The Examiner makes this allegation in the passage below:

> Foster teaches a process for copying items to a display space (clipboard) for later use in insertion into a document (see column 7, line 56 through column 8, line 15 and in figures 4e-4f), similar to that of MSword, but further teaches, in the second process, that upon a user selection of an item from the group of clipped items the user is provided with a visual depiction of the actual object the pointer is positioned over (see column 9, lines 44-65 and figure 5c) where elements available for clip based storage include both text elements and graphic elements (see column 7, line 56 through column 8, line 15 and in figures 4e-4f). Foster further teaches the ability for clipboard icons to indicate the actual content of the clipboard object, showing a miniature version of the actual graphical object (see column 12, lines 18-23).

Office Action dated June 5, 2008 p. 6.

Foster is directed to a visible clipboard implemented on a pen-based computer system including a touch sensitive screen and a stylus. The stylus is used to select an image displayed on a screen, and the image is dragged by the stylus across the screen until a boundary is impinged. *Foster* is further directed to moving the visual clipboard including the steps of selecting a visual clipboard icon on a computer screen, dragging the icon on the screen with a pointing device, and depositing the icon when a boundary on the computer screen is impinged. In addition, *Foster* also teaches selecting an object, converting the object to an icon by dragging the object to a second location, dragging the icon to a third location on the screen, and converting the icon back to the object at the third location. (See *Foster* Col. 2, lines 55 through col. 3 line 3).

The Examiner relies on the following passage to allegedly teach the claim 1 recited, "displaying the graphical image associated with the icon in response to the icon preview instruction."

> In **FIG. 5c**, visible clipboard icon **92** can be selected by placing a point 112 of stylus **38** near or within its bounding box. In this instance, *the selection of*

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the icon 92 causes a text object T' to appear on the screen which can be dragged as indicated by the arrow 114. When the point of the stylus 38 reaches the point 112', it can be lifted from the screen as indicated by circle 114 to "paste" the text object T at that location.

Foster col. 9, lines 44-51 (emphasis added).

It is therefore apparent that there are several embodiments for a process for moving a visible clipboard icon. In one process, the icon is moved without modifying the visual appearance of the icon, and then is either attached to another boundary or is converted into an object image on the screen 72. *In the second process, the visible clipboard icon is converted into the object that it is carrying, which is then dragged across the screen 72* to either be placed into an application program or to be reconverted into a visible clipboard icon if it impinges upon another boundary. The advantage of the second process is that a user can see the object and therefore more accurately position the object for pasting into the application program.

Foster col. 9, lines 52-65 (emphasis added).

Applicant suggests reviewing the following regarding the nature of "carrying":

In FIG. 5b, the graphical object G that had been "carried" by the visible clipboard 82 has been "pasted" into the notepad application centered at the point 106' where the stylus 38 left the screen 72. Of course, the graphic object G could be pasted at other positions relative to point 106'. For example, the point 106' could comprise the lower left-hand corner of the bounding box for the graphic object G.

Foster col. 9, lines 36-43 (emphasis added).

As can be seen, *Foster* teaches 1) selecting the icon by placing a point of stylus near or within the icon's bounding box; 2) dragging the clipboard to convert the icon into the object that it is carrying; and 3) detecting that the stylus left the screen and pasting the graphical object G.
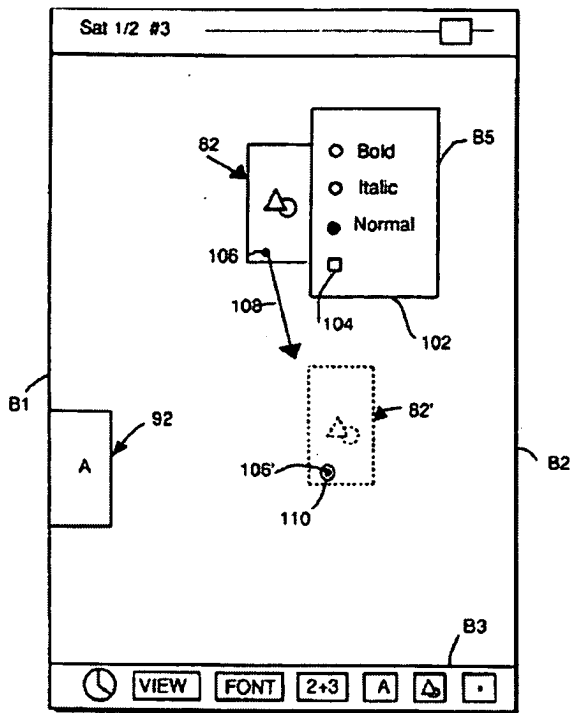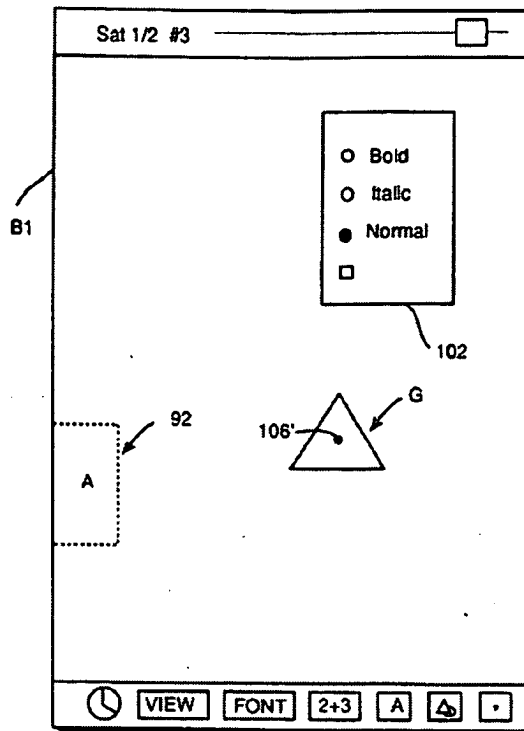
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Fig. 5a

Fig. 5b

As can be seen in *Foster* Figures 5A and 5B, the stylus is dragged from point **106** along the path **108** to the point marked **106'**, at which the stylus leaves the screen. The figures clearly show an icon remains present through the dragging path of the stylus, and is, in fact, the manner by which the 'graphical object G' is 'carried' by the icon, as described in *Foster* passages above. *Foster* goes on to say:

> ... the arrow **108**. Once at the position **82'**, the point **106'** of the stylus is lifted from the screen as indicated by the circle **110**. Since the point **106'** is not near any boundary of the screen **72**, i.e, is not near any boundary such as **Bl-B5**, the computer system **10** determines that this is a gesture indicating that the contents of the visible clipboard **82** are to be pasted to the application program at or near the point **106'**.

Foster col. 9, lines 28-35.

As can be seen, *Foster* teaches that the contents, that is, the actual graphic object, are pasted or 'converted' in response to the stylus being lifted from the screen. In contrast, claim 1 recites, "displaying the graphical image associated with the icon in response to the icon preview instruction." Clearly, *Foster* is not displaying the graphic object in response to an icon preview

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instruction. Instead, *Foster* teaches a complete use of the paste buffer. The entire act of pasting is completed when *Foster* actually shows the graphic object. Accordingly, nothing remotely in *Foster* can be considered a preview or response to an icon preview instruction in the manner claimed. The operation disclosed in *Foster* completely defeats the operation and advantage of claim 1, and instead produces the disadvantage described in the background of the present invention, "the operator can't preview the images before selecting an image to insert into the document" (Specification paragraph 0004). More importantly, *Foster* does not respond to an icon preview instruction as recited in claim 1. Instead, *Foster* responds to the actual paste command given when the stylus leaves the display. For this reason, the Examiner has not made a *prima facie* case of obviousness under 35 U.S.C. § 103(a). Accordingly, it is respectfully urged that claim 1 is allowable.

Even if *Foster* did teach to display the graphical image associated with the icon in response to the icon preview instruction, which it does not, the teachings of *MSword* and *Foster* are not combinable.
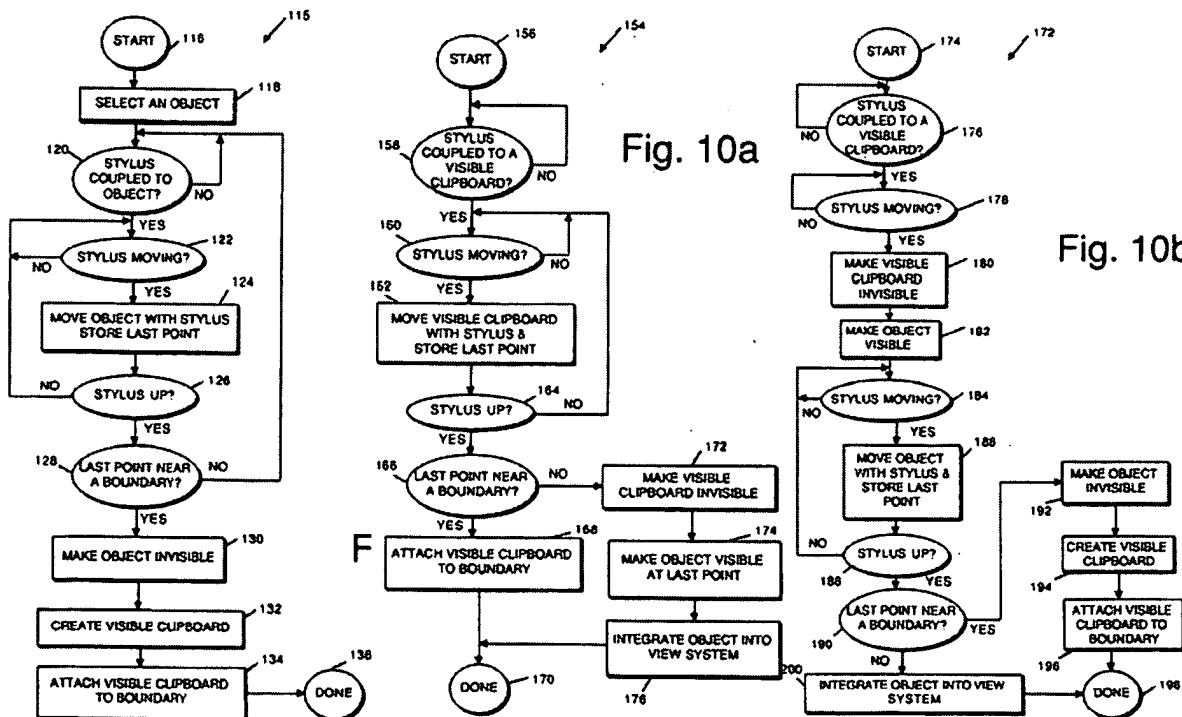
Foster, Figures 6, 10a and 10B.

One of ordinary skill in the art would not have been motivated to combine the teachings of *MSword* with *Foster*. The Examiner supplements the terse images of *MSword* with "Word 2000 Basic Manual page 8", "If you position the mouse cursor arrow over a toolbar button, after a couple of seconds, the name of the button will appear in a little yellow box." *Foster*, in contrast, makes changes in visibility conditioned on a stylus moving. See, in particular, blocks **122, 160**, and **178**, respectively, of *Foster* **Figures 6, 10A,** and **10B**. Since *MSword* and *Foster* clearly contradict each other, one of ordinary skill in the art would not be able to combine these teachings to reach the claimed invention. Accordingly, for this additional reason, it is respectfully urged that the rejection under 35 U.S.C. § 103(a) be withdrawn.

An additional reason one of ordinary skill in the art would not combine *MSword* and *Foster* is evident at *Foster's* description of **Figure 9A**. *Foster* explains the nature of the icon -- that "a visible clipboard icon **150a** includes indicia **152** which is a miniature version of the actual graphical object carried by the icon **150a**." (see *Foster* col. 12, lines 21-23). Accordingly, *Foster* teaches away from displaying the claim 1 recited, "graphical image associated with the icon in response to the icon preview instruction". How can *Foster* display an image in response to an icon preview instruction, if the image is already present on the *Foster* icon? *Foster* presents the image as part of the icon. There is no previewing. The *Foster* combination of the icon and image at the outset into one object when combined with the teachings of *MSword* would make the claimed preview instruction superfluous and unnecessary. Accordingly, one of ordinary skill in the art would not be motivated, once *Foster* and *MSword* are combined, to even use an icon preview instruction as claimed. Accordingly, for this additional reason, it is respectfully urged that the rejection under 35 U.S.C. § 103(a) be withdrawn.

Since claims 2 and 3 depend from claim 1, the same distinctions between claims 2 and 3 and the claimed invention in claim 1 apply to these claims. Additionally, claims 2 and 3 claim other additional combinations of features not suggested by the reference. For example, with respect to claim 3, the Examiner alleges that *Foster* teaches the claim 3 recited, "displaying a reduced image of the graphical image." Claim 3 states that the displaying step is in response to the icon preview instruction. Consequently, it is respectfully urged that the rejection of claims 2 and 3 have been overcome for these additional reasons.

With respect to claim 9, the Examiner alleges identity between the claimed subject matter

and the prior art in a manner similar to claim 1. Claim 9 is recited below:

> Computer usable medium including a program for previewing a graphical image corresponding to an icon in a clipboard, comprising:
> computer readable code for receiving an icon preview instruction from a user; and
> computer readable code for displaying the graphical image associated with the icon in response to the icon preview instruction.

The standard of review applied to findings of fact is the "substantial evidence" standard under the Administrative Procedure Act (APA). See *In re Gartside*, 203 F.3d 1305, 1315, 53 USPQ2d 1769, 1775 (Fed. Cir. 2000). See also MPEP § 1216.01. As noted by the court in *In re Ahlert*, 424 F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA 1970), the notice of facts beyond the record which may be taken by the examiner must be "capable of such instant and unquestionable demonstration as to defy dispute" (citing *In re Knapp Monarch Co.*, 296 F.2d 230, 132 USPQ 6 (CCPA 1961)).

The Examiner does not allege that either *MSword* or *Foster* teaches claim 9 recited, **"computer readable code for** displaying the graphical image associated with the icon in response to the icon preview instruction." The Examiner makes the following remarks concerning claim 9.

> 14. With regard to claim 9, which teaches a computer usable medium including a program for previewing a graphical image corresponding to an icon in a clipboard (see MS figure 2), comprising: computer readable code for receiving a icon preview instruction from a user, MSword teaches, in MS figure 2, the user accessing a preview of a clipboard item through a mouse over event. With regard to claim 9, further teaching computer readable code for displaying the graphical image associated with the icon in response to the icon preview instruction, MSword teaches, in MS figure 2, the system displaying a textual preview of a clipboard item in response to a mouse over event.

Office Action dated June 5, 2008, pages 7 and 8.

MSword Figure 2 is shown below:
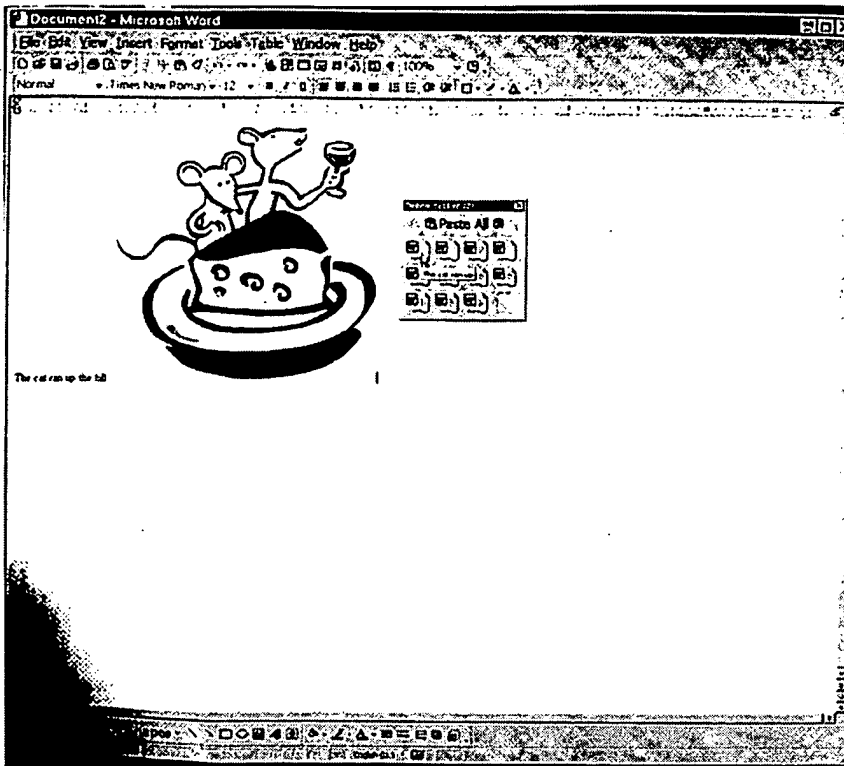
Claim 9 specifically recites, "**computer readable code** for receiving an icon preview instruction from a user". As can be seen, Figure 2 shows some activity, but is silent concerning whether computer usable code is the cause of the activity. The Examiner's remarks that Figure 2 shows "a user accessing a preview of a clipboard item through a mouse over event," is a non sequitur and irrelevant, since the Examiner does not allege that *MSword* shows any computer readable code. At best, the Examiner alleges that *MSword* shows some user activity, "accessing" or that the "icon preview instruction from a user" is a "mouse over event". One of ordinary skill in the art would not regard "accessing" or the other user activity action of "mouse over event" as computer readable code. Since the art used are only screen shots, the *MSword* figures are useful only to show the outward effects with respect to outcomes made by moving two-dimensional items across a screen. To the extent that the Examiner is relying on personal knowledge to suggest that computer readable code is used in *MSword*, the Examiner is making an inference not present in the Figures shown. The images alone, do not teach one of ordinary skill in the art to make or practice computer readable code as recited in claim 9. Accordingly, claim 9, for at least this reason, is allowable.

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The Examiner goes on to state that *Foster* teaches some portion of the claim 9 recited, "**computer readable code** for displaying the graphical image associated with the icon in response to the icon preview instruction."

> Foster teaches a process for copying items to a display space (clipboard) for later use in insertion into a document (see column 7, line 56 through column 8, line 15 and in figures 4e-4f), similar to that of MSword, but further teaches, in the second process, that upon a user selection of an item from the group of clipped items the user is provided with a visual depiction of the actual object the pointer is positioned over (see column 9, lines 44-65 and figure 5c) where elements available for clip based storage include both text elements and graphic elements (see column 7, line 56 through column 8, line 15 and in figures 4e-4f). Foster further teaches the ability for clipboard icons to indicate the actual content of the clipboard object, showing a miniature version of the actual graphical object (see column 12, lines 18-23). It would have been obvious to one of ordinary skill in the art, having the teachings of MSword and Foster before him at the time the invention was made to modify text based representation of the contents of a clipped item of MSword to include a graphical representation of the actual object being dragged. One would have been motivated to make such a combination so as to allow the user to "see the object and therefore more accurately position the object for pasting into the application program" (see Foster column 9, lines 63-65).

Office action dated June 5, 2008, page 8.

As can be seen, the Examiner's remarks are completely devoid of any comment regarding the claim 9 recited, "computer readable code". The Examiner does not use *MSword* to cure the deficiency of *Foster*. Accordingly, the Examiner has not provided a *prima facie* case of obviousness under 35 U.S.C. § 103(a). For this additional reason, Applicants respectfully urge that claim 9 is in a condition for allowance.

As a third rationale for allowing claim 9, in addition to the above stated deficiency, the Office Action also fails to state the claim 9 recited, "displaying the graphical image associated with the icon in response to the icon preview instruction." The Examiner re-uses arguments of claim 1 to apply those arguments to the more limited claim 9. Accordingly, the same reasons for allowing claim 1 apply to claim 9, with respect to those claim recitations that are identical in claims 1 and 9.

Since claims 10-11 depend from claim 9, the same distinctions between claims 10-11 and the claimed invention in claim 9 apply to these claims. Additionally, claims 10-11 claim other additional combinations of features not suggested by the reference. For example, computer

usable code for determining whether a display position indicator is positioned over the icon displayed in the clipboard for a predetermined time period (claim 10), or computer readable code for displaying a reduced image of the graphical image (claim 11). Consequently, it is respectfully urged that the rejection of claims 10-11 have been overcome for these additional reasons.

IV. Conclusion

It is respectfully urged that the subject application is patentable over *MSword* and *Foster* and is now in condition for allowance.

The Examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the Examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

DATE:_____8/6/2008_____

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